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08/167,846	12/23/93	KING	

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F P30104

EXAMINER

SPRINGER, D

ART UNIT

PAPER NUMBER

1201

4

DATE MAILED:

10/13/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 1 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 11-28 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. Claims _____ have been cancelled.
3. Claims _____ are allowed.
4. Claims 11-13, 15 and 18-28 are rejected.
5. Claims 14, 16 and 17 are objected to.
6. Claims _____ are subject to restriction or election requirement.
7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. Formal drawings are required in response to this Office action.
9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).
11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).
12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.
13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. Other

EXAMINER'S ACTION

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Claims 11-28 are pending.

Claims 19-27 are rejected under 35 USC 112, par. 1 as having inadequate enabling description for and under 35 USC 112, par. 2 as indefinite in the term:

"or a salt thereof".

Embraced are any and all "salts" known and yet to be discovered many with toxic and other non-pharmaceutically acceptable attributes which are undescribed.

The term "salts" fails to set metes and bounds as to what is and what is not embraced thereby and leaves this for others to so determine by subsequent undue experimentation. The term "pharmaceutically acceptable salts" does have definite metes and bounds and does describe what is claimed.

Claims 19-27 are also rejected under 35 USC 112, par. 2 as indefinite as improperly dependent upon Claim 11, a method of use claim. A compound claim must be dependent upon a compound since it is the structure of the compounds that is being claimed not their method of use.

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Claim 28 is rejected under 35 USC 112, par. 2 as improperly dependent upon claim 11 a method of use claim which does not claim compounds, but claim 28 refers to a "compound of formula I", therein. A composition claim must be dependent upon a compound claim since it is the structure of the compounds in the independent claim upon which the composition depends for its efficacy. Correction or cancellation of claim 28 is accordingly required.

Claim 18 is rejected under 35 USC 112, par. 1 as lacking enabling description for "as hereinbefore defined," ^{because} ~~since~~ this can only mean the specification since no compound claim more generic than it is mentioned nor is any claim referred to.

Claims 11-13 and 15 are rejected under 35 USC 112, par. 1 as lacking enabling description for and under 35 USC 112, par. 2, as indefinite in the term "or R⁵ and R⁶ together with the nitrogen atom to which they are attached form a ring" since the ring size and/or unsaturation or substituents thereon (if any) are not described. Metes and bounds as to what is and what is not embraced thereby can only be determined by the subsequent undue

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experimentation of others.

Claims 11-13 and 15 are rejected under 35 USC 112, par. 1 as having inadequate enablement as to how to make and use compounds embraced by the term "or R⁵ and R⁶... a ring".

How to make Sources of starting materials therefore and thus how they can be made has not been shown. All must be enabled as of the filing date In re Howarth 210 USPQ 689 and Ex parte Moersch 104 PQ 122.

How to use Not having been made reasonable assurance is lacking that compounds embraced by this term would be useful in the utility urged. In re Surrey 151 USPQ 122; In re Fouche' 169 USPQ 429.

Claims 14, 16 and 17 are considered allowable if in independent form and accordingly are objected to.

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October 07, 1994

David B. Springer
DAVID B. SPRINGER
PRIMARY EXAMINER
ART UNIT 1201